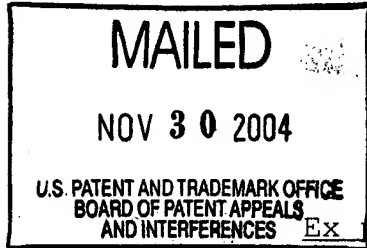


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN E. GARDELL, ISRAEL B. ZIBMAN
and GREGORY C. DEPP

Appeal No. 2004-1576
Application No. 09/177,700

ON BRIEF

Before HAIRSTON, BARRETT, and RUGGIERO, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we hereby remand the application to the examiner for consideration of our findings and to take appropriate action.

In the final rejection (paper number 20), claims 1 through 3 and 6 through 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar (U.S. Patent No. 6,006,253) in view of Pang (U.S. Patent No. 6,298,045), and claims 4, 5 and 17 through 19 were

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rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Skarbo (U.S. Patent No. 5,546,447) and Pepper (U.S. Patent No. 5,930,700). In the answer (paper number 26), claims 1 through 14 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Kumar and Pang, and claims 15 through 19 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Kumar, Pang and Pepper.

Based upon the foregoing, it is apparent that the examiner has now included claims 4 and 5 under the obviousness rejection based upon the combined teachings of Kumar and Pang, moved claims 15 and 16 from the obviousness rejection based upon the combined teachings of Kumar and Pang, removed Skarbo as a reference in the obviousness rejection of claims 4, 5 and 17 through 19 as set forth in the final rejection, and added the reference to Pepper in the obviousness rejection of claims 15 through 19.

Although the appellants are willing to treat the reconfigured obviousness rejections of claims 1 through 18 as harmless error, they are not willing to do the same for claim 19 (reply brief, pages 2 and 3). Thus, we must agree with the appellants' argument (reply brief, page 2) that the rejection of claim 19 "constitutes a new ground of rejection that substantially limits Appellants'

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